

REMARKS

Claims 12-25 and 31 are pending in the case. The Examiner's reconsideration of the objection and rejections is respectfully requested in view of the amendments and the remarks.

Applicants appreciate the Examiner's indication that claim 19 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The courtesies extended by the Examiner during the telephone conversation of 3/30/05 were appreciated. It was determined that claim 31 stands rejected under 35 U.S.C. 101 together with claims 1-18, 20-25, 29 and 30.

Claims 1-18, 20-25, and 29-31 have been rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. Applicants respectfully disagree.

Claim 12 claims, *inter alia*, "parameterizing the flexible endoscope according to a plurality of parameters for handling the endoscope given a desired task; determining, pre-operatively, at least one endoscope configuration of the parameters, based on a predetermined patient model; and determining instructions for handling the endoscope according to the configuration."

Claim 12 includes limitations to pre-computer processing activity, e.g., "parameterizing the flexible endoscope according to a plurality of parameters for handling the endoscope given a desired task." The measurement of physical objects, such as parameterizing a flexible endoscope, constitutes a pre-computer process of collecting real world data. Such pre-computer processing activity puts claim 12 within the safe

harbor afforded process claims including a physical transformation outside a computer. Therefore, claim 12 is believed to be directed to statutory subject matter under 35 U.S.C. 101.

In addition, the limitation “determining instructions” of claim 12 is believed to be a practical application. The process claimed in claim 12, e.g., “parameterizing the flexible endoscope according to a plurality of parameters for handling the endoscope given a desired task; determining, pre-operatively, at least one endoscope configuration of the parameters, based on a predetermined patient model”, is practically applied to determine instructions; a concrete and tangible result. It has been held that a machine programmed to transform data which represents discrete dollar amounts into a final share price through a series of mathematical calculations does, in fact, constitute the practical application of a mathematical algorithm, formula, or calculation because it produces “a useful, concrete and tangible result” i.e., the final share price upon which investors and their brokers can make investment decisions (see *State Street*, 149 F.3d at 1374-75, 47 USPQ 2d at 1602). Similarly, the instructions of claim 12 are a useful, concrete and tangible result of an idea, e.g., “determining, preoperatively, at least one endoscope configuration of the parameters, based on a predetermined patient model”, practically applied, and thus are believed to satisfy 35 U.S.C. 101.

For at least the foregoing reasons claim 12 is believed to satisfy the requirements of 35 U.S.C. 101.

Claims 1-11, 29 and 30 have been cancelled. Claims 13-25 and 31 depend from claim 12. The dependent claims are believed to be allowable for at least the reasons given

for claim 12. At least claims 18, 20, 22 and 24 are believed to be allowable for additional reasons.

Claims 18, 20, 22, and 24 claim, "determining an endoscope length", "determining a shaft-rotation of the endoscope", "determining a bending angle of the endoscope" and "determining a tool length", respectively. These determinations are pre-computer processing activities, e.g., the measurement of a physical object (endoscope). Claims to pre-computer processing activities are within the safe harbor of 35 U.S.C. 101. Therefore, claims 18, 20, 22 and 24 are believed to be allowable.

The Examiner's reconsideration of the rejection is respectfully requested.

Claims 1-11, 29 and 30 have been rejected under 35 U.S.C. 102(b) as being anticipated by Guthrie et al. (U.S. Patent No. 6,409,686). The Examiner stated essentially that Guthrie teaches all the limitations of claims 1-11, 29 and 30.

Claims 1-11, 29 and 30 have been cancelled.

Claims 1-9 and 29 have been rejected under 35 U.S.C. 102(e) as being anticipated by Alft et al. (U.S. Patent Application No. 2003/0173113). The Examiner stated essentially that Alft teaches all the limitations of claims 1-9 and 29.

Claims 1-9 and 29 have been cancelled.

For the forgoing reasons, the present application, including claims 12-25 and 31, is believed to be in condition for allowance. The Examiner's early and favorable action is respectfully urged.

Respectfully Submitted,

Date: March 31, 2005

Donald B. Paschburg

Donald B. Paschburg

Reg. No. 33,753

Attorney for Applicants

Mailing Address:

SIEMENS CORPORATION
Intellectual Property Department
5th Floor
170 Wood Avenue South
Iselin, New Jersey 08830
(732) 321-3191
(732) 321-3030 (FAX)